

Appl. No. : **10/509,226**
Filed : **April 14, 2005**

REMARKS

Claims 1-2, 7-8, and 10 have been canceled without prejudice. Claim 6 has been amended to include the limitations of claims 1 and 2. Claims 3-5, 9, 11, and 12 have been amended to depend ultimately from claim 6. Claims 13-22 have been added. Support for claim 13 can be found in the examples on pages 22-23, for example. Support for claim 14 can be found on page 1, lines 20-25, and page 6, lines 18-21, for example. Support for claim 15 can be found on page 10, lines 1-4, for example. Support for claim 16 can be found on page 6, lines 7-8, for example. Support for claims 17-21 can be found on page 3, line 26 through page 6, line 6, for example. Support for claim 22 can be found in the examples on pages 22-23, for example. No new matter has been added. Applicant respectfully requests entry of the amendments and reconsideration of the application in view of the amendments and the following remarks.

Rejection Under 35 U.S.C. § 102

Claims 1-4 and 7-9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Asahi (JP55-039329A). Claims 1-2 and 7-8 have been canceled without prejudice. Claims 3, 4, and 9 have been amended to depend ultimately from claim 6 which has not been rejected on this ground. Thus, this rejection is moot.

Please note that although the Examiner cites Asahi (JP55-039329A), this reference was not listed in PTO-892 or PTO-1449, and a copy of the reference was not provided. Thus, Applicant requests indicating this reference in Form \$ and providing a copy of the reference.

Claims 1-4 and 7-9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Sumitomo (JP51-04330A). Claims 1-2 and 7-8 have been canceled without prejudice. Claims 3, 4, and 9 have been amended to depend ultimately from claim 6 which has not been rejected on this ground. Thus, this rejection is moot.

Claims 1-4 and 7-9 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Asahi '835 (JP55-040835A). Claims 1-2 and 7-8 have been canceled without prejudice. Claims 3, 4, and 9 have been amended to depend ultimately from claim 6 which has not been rejected on this ground. Thus, this rejection is moot.

Claims 1 and 6 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Ishii (US6120655). Claim 1 has been canceled without prejudice. Claim 6 has been amended to include

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the limitations of claim 1 and claim 2 which has not been rejected on this ground. Thus, this rejection is moot.

Additionally, the clear coated paper recited in claim 6 can maintain slipping property without generating scum production even in an environment of high shearing load (e.g., page 14, lines 21-29). The above effect according to the structures recited in claim 6 could not be reasonably expected by one of ordinary skill in the art from the prior art of record.

Rejection Under 35 U.S.C. § 103

Claims 5 and 10-12 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Asahi, Asahi '835, or Sumitomo, and further in view of Kato (US5995785). These claims have been amended to depend ultimately from claim 6 which has not been rejected on this ground. Thus, this rejection is moot.

New claims

Claims 13-22 have been added, which depend ultimately from claim 6. As discussed above, claim 6 should be patentable, and at least for this reason, claims 13-22 also should be patentable.

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CONCLUSION

In light of the Applicant's amendments to the claims and the foregoing Remarks, it is respectfully submitted that the present application is in condition for allowance. Should the Examiner have any remaining concerns which might prevent the prompt allowance of the application, the Examiner is respectfully invited to contact the undersigned at the telephone number appearing below.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

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